



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/865,841	05/30/1997	JAKOB NIELSEN	2860-059-P22	8979
22852	7590	01/04/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			COBY, FRANTZ	
			ART UNIT	PAPER NUMBER
			2161	
DATE MAILED: 01/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/865,841

Applicant(s)

NIELSEN, JAKOB

Examiner

Frantz Coby

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2161

This is in response to Applicant's amendment filed on October 05, 2005 in which claims 1-26 are presented for examination.

Status of Claims

Claims 1-26 are pending.

Response to Arguments

Applicant's arguments filed on the aforementioned date have been fully considered but they are not persuasive. Thus, the rejection of claims 1-26 mailed on July 05, 2005 remains.

The rejection follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cochran U.S. Patent no. 5,995,979.

As per claim 1, Cochran discloses "a web server for information retrieval" by providing a plurality of computers connected in a network including an internet link (See Cochran figure 1, components 720) including computer software that permit the accessing of data from a computer database (See Cochran Col. 5, lines 40-42). As to the claimed features of "a bus", this feature is primarily incorporated in the computers disclosed by Cochran since a bus is a set of hardware lines or conductors used for data transfer among the components of a computer system. The Applicant should duly note that "a processor" is inherent in a computer" because it is the computational and control unit of a computer. As to the claimed limitations of "a network interface connected to the bus", Cochran discloses that each computer (Figure 1 component 720) has memory space 717 and a monitor device 725. It would be apparent that each of the computers of Cochran includes an interface that connects pieces of hardware with the processor so that information can be moved from place to place. Cochran has shown the claimed limitations of "information storage accessible through the bus and containing stored information" as a CD-ROM (See Cochran Col. 5, lines 39-41) and it is also apparent that the CD-ROM would be connected to a bus to properly function with the processor. As to a processor configured to "receive search queries from a client" and "process those queries" Cochran provides a mechanism such as computer software which permits the accessing of data from a computer database" (See Cochran Col. 5, lines

Art Unit: 2161

40-41). In particular, claim 1 recites a processor "to provide a list of terms used in the search queries presented over a period of time, wherein the list of terms are selectively added to the stored information against which the search queries are processed".

Cochran discloses the aforementioned claimed limitations by providing a method for managing the presentation of search terms on a computer wherein multiple lists of search terms are displayed, a search is conducted based upon selected search terms from one or more of the multiple search lists, also, the records identified by the search is used to form new lists of search terms (See Cochran Abstract', Col. 4, lines 1-57; Figure 2 and corresponding text).

As per claims 2-3, most of the limitations of these claims have been noted in the rejection of claim 1 . Applicant's attention is directed to the rejection of claim 1 above. In addition, Cochran disclose the claimed limitations of "a term to be selectively added Is added to a document of file as a meta-tag", by allowing entry to be made in the lists', thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear organization that allows elements to be added or removed. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1, lines 1 1-12) as an entry in a meta-information section of a document or a file. As to the claimed feature of "a term to be selectively added is also added to an inverted index" Cochran achieved this limitation by providing lists of search terms where the lists can be updated (See

Cochran Figures 3-10b) Thus, It would be apparent from Cochran's use of updating lists that terms must be added to an inverted index to effectively create alternative locators for the search terms in the lists.

As per claim 4, Cochran discloses an information retrieval system" by providing a plurality of computers connected in a network (See Cochran figure 1, components 720) including computer software that permit the accessing of data from a computer database (See Cochran Col. 5, lines 40-42). In particular, Cochran discloses the claimed limitations of "a network"" "a plurality of users connected to said network" by providing a computer communication network (See Cochran Figure 1). Further, Cochran discloses the claimed features of "at least one server connected to said network, said server containing stored items and searching the stored items in response to search queries submitted by users" (See Cochran Col. 5, line 65- Col. 7, line 4). Last, Cochran discloses the claimed limitations of "said server configured to provide a list of terms used in search queries over a period of time, wherein the list of terms are selectively added to at least one of the stored items which were used for the search" by providing a method for managing the presentation of search terms on a computer wherein multiple lists of search terms are displayed, a search is conducted based upon selected search terms from one or more of the multiple search lists, also, the records identified by the search is used to form new lists of search terms (See Cochran Abstract', Col. 4, lines 1-57., Figure 2 and corresponding text). As to a web browser, Cochran discloses the use

of Netscape and Air Mosaic used to access and browse web pages (See Cochran Col. 6, line 65-Col. 7, line 4).

As per claims 5-6, most of the limitations of these claims have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above. In addition, Cochran disclose the claimed limitations of "a term to be selectively added is added to a document of file as a meta-tag; by allowing entry to be made in the lists', thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear organization that allows elements to be added or removed. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1 , lines 1 1-12) as an entry in a meta-information section of a document or a file. As to the claimed feature of "a term to be selectively added is also added to an inverted index" Cochran achieved this limitation by providing lists of search terms where the lists can be updated (See Cochran Figures 3-10b). Thus, It would be apparent from Cochran's use of updating list that terms must be added to an inverted index to effectively create alternative locators for the search terms in the lists.

As per claim 7, most of the limitations of this claim have been noted in the rejection of claims 1 and 4 above. In addition, Cochran discloses the claimed feature of providing an element for storing a list of queries submitted by a client to a search engine

Art Unit: 2161

on a website" and "an element for storing a list terms" by providing memory spaces for retaining search request (See Cochran Col. 6, lines 40-52). Also, Cochran discloses the claimed limitations of "providing an element for selecting" (See Cochran Col. 7, lines 48-54). Last, Cochran discloses the claimed limitations of "processing each search term of said portion and selectively adding each search term to documents or files stored in said systems as a meta-tag" by allowing entry to be made in the lists, thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists, of Cochran (See Cochran Figures 3-10b), are multi-element data structure that has a linear organization that allows elements to be added or removed. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1, lines 11-12) as an entry in a meta-information section of a document or a file.

As per claims 8-10, most of the limitations of these claims have been noted in the rejection of claims 7 and 4 above. In addition, Cochran discloses the claimed feature of "presenting the term to a user together with at least identifiers of a number of documents or files stored in said system containing said term; presenting the term to a user together with at least portions of a document identified by one of said identifiers" (See Cochran. col. 7, line 10-Col. 9, line 59)', "said term is presented to a user with portions of a document in a graphical user interface having a user activatable function for adding a term to said document as a meta-tag" (See Cochran Figures 3a-9d and corresponding text).

As per claims 11-12, most of the limitations of these claims have been noted in the rejection of claim 7. Applicant's attention is directed to the rejection of claim 7 above. In addition, Cochran disclose the claimed limitations of "providing an element for selectively adding said term to said document as a meta-tag"; by allowing entry to be made in the lists. thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear organization that allows elements to be added or remove. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1 , lines 11-12) as an entry in a meta-information section of a document or a file. As to the claimed feature of "providing an element for adding information about the term added to said document as a meta-tag in an inverted index" Cochran achieved this limitation by providing lists of search terms where the lists can be updated (See Cochran Figures 3-10b). Thus, It would be apparent from Cochran's use of updating list that terms must be added to an inverted index to effectively create alternative locators for the search terms in the lists.

As per claim 13, all the limitations of this claim have been noted in the rejection of claims 1-12. Namely, "providing an element for storing" and "providing an element for adding". It is therefore rejected as set forth above.

As per claim 14, all the limitations of this claim have been noted in the rejection of claims 1-12. Namely, "providing an element for generating a term", "providing an element for generating a list" and using the list and the term for adding to documents containing those terms as a meta-tag and stored at web server. It is therefore rejected as set forth above.

As per claims 15-17, all the limitations of these claims have been noted in the rejection of claims 14 as well as claims 2-3 including terms to be added as meta-tag. They are therefore rejected as set forth above.

As per claims 18-26, most of the limitations of these claims have been noted in the rejection of claims 1-17. In addition, Cochran discloses sorting query terms (See Cochran Figure 3D and corresponding text; eliminating noise words or stop words (Figure 3c and corresponding text)). Also, claims 18-26 set forth features that are inherent to carry out the invention as detailed in the analysis above. Namely, providing an element for extracting terms used in search query is inherent in a database since the primary purpose of submitting a query to a database is to extract information associated with the submitted query. Presenting those terms to said server is also inherent since a query result must be presented to a user when a query is submitted to indicate to the user whether any document was found according the submitted query. As to a computer program product, Cochran provides apparatus, method as well as computer software for implementing the invention (See Cochran Title; Col. 5, lines 40-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brunner et al. U.S. Patent no. 5,550,971 in view of Cochran.

As per claims 19-20 and 25, Brunner et al. teaching of a database management system with adaptive user interface reads on the claimed features of "providing an element for extracting terms and presenting those terms to a user; providing an element for identifying a document containing a term; determining if the document contains subject matter related to said term', and providing an element for adding said term to said document as a meta-tag if it does; receiving a user selection of terms" (See Brunner Abstract', and Col. 2, line 45-Col.3, line 22. Col. 4, lines 54-60). It is noted, however Brunner et al. did not specifically detail the aspects of adding the received terms to a document as a meta-tag. On the other hand, Cochran achieved the aforementioned limitations by providing "a search of the database is conducted based upon selected search terms" (2) subset of records identified by the search is used to form new list of search terms" and (3) "the matching records or hits are added/stored at the server 710". As to the aspect of adding as meta-tag. Cochran provides mechanism that allows terms added in the list to be viewed or access as meta- tag because "FIG.

Art Unit: 2161

3b shows a list of search terms 211 that is displayed if the user expands pick box 311 corresponding to the first list identifier 111, Start of Travel. Here, there is five search terms 211 to choose from: January-March, April-June, July-September, October-December and Disregard Start of Travel. The default search term, January-March is highlighted and placed in the select box in order to indicate the search term that will be selected if no other term is selected. If the user had previously selected a term during a previous viewing of the search terms, that term will be highlighted as the default term. Once a pick box 31 1 has been expanded, a search term 21 1 may be selected by clicking on the desired search term 21 1 with the cursor (step 18). The expanded pick box 31 1 will then close, leaving the selected search term 21 1 visible on the display device (step 20). If the expand field icon 411 is activated without selecting a search term 211, pick box 31 1 will close, leaving the default search term, January- March visible on the display device, as shown in FIG. 3c". The most important part of the description of Figure 3b, in another to understand the teachings of Cochran with respect to meta-tag or information about information, is a list of search terms 211 that is displayed if the user expands Dick box 31 1 corresponding to the first list identifier 111 (Sta4 of Travel). In this case, the first list identifier 111 (Start of Travel) is the data that describes meta-data list of search terms 211 because when Start Travel is selected the meta-data for a corresponding list of search terms are displayed within the travel search database window.

It would have been obvious to modify the database management system of

Brunner et al. by incorporating the methodology of adding search terms to stored information taught by Cochran. The motivation being, to allow the data management system of Brunner et al to save computer resources, especially on-line transmission resources, and makes searching more accurate and user-friendly.

Remarks

The Applicant argued that, "Although Applicant believes that claims 1-26 are allowable without further amendment, to expedite prosecution, Applicant has amended the claims to more clearly specify that an embodiment consistent with the present invention can operate in a Web environment. Because the cited art does not teach disclose features recited in claims 1-26 as amended, Applicant respectfully requests the Examiner to withdraw the rejections of these claims under 35 U.S.C. 102(e) and allow the claims. In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of claims 1-26". The Examiner respectfully submits that Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Further, the Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 571 272 4017. The examiner can normally be reached on Monday-Saturday 3:00PM-10: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571 272 4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 25, 2005


FRANTZ COBY
PRIMARY EXAMINER